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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,868	02/12/2002	Daniel D. Berns	8350.0537-00	2428

7590 11/19/2004
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

LAWRENCE JR, FRANK M

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,868

Applicant(s)

BERNS ET AL. A

Examiner

Frank M. Lawrence

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20, 22-28, 30 and 32-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-17, 22-28, 30, 32-56 and 58-68 is/are allowed.
- 6) ☒ Claim(s) 18-20 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 57 recites the limitation "the dynamometer test" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. This rejection may be overcome by changing the recitation to "a dynamometer test".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Haarstad et al. (4,496,460).

7. Haarstad et al. '460 teach a filtration loop for cleaning a lubricant fluid from a vehicle engine, comprising a pump (12) for drawing fluid, a strainer filter (18) upstream of the pump, and a second filter (26,54) downstream of the pump for removing smaller particulates (figure 4, col. 1, lines 11-26, 60-67, col. 4, lines 14-30). The point in time at which the pump draws engine fluid from the engine does not further limit the claimed structure in any way that distinguishes the claim over the prior patent.

8. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Verdegan et al. (5,968,371).

9. Verdegan et al. '371 teach a system for on-line particle counting in an automobile engine lubrication system, comprising an engine (14), an oil circulation loop (20), an external pump (18) for circulating oil and draining to a sump (16), a filter (12) upstream of the pump via the circulation loop, optical particle counting sensors (26, 28, 30) upstream (unfiltered) and downstream from the filter, an initializing step (46) for the system, a controller (22) and timer (48) for controlling sampling, and a display (24) for indicating results to an operator (figure 1, col. 1, lines 5-11, 36-47, col. 7, lines 23-44, col. 9, lines 27-33, col. 10, lines 27-31). The system may be used to indicate the need for a filter change by an operator or can initiate an automatic filter cleaning cycle (col. 10, lines 31-38) when the particle count is too high, after which a second sampling period will take place with the new or cleaned filter, meeting the limitation of initiating operation of a filtration system when the characteristic of cleanliness exceeds a threshold value. The system can indicate imminent catastrophic failure if large or highly

reflective particles become present in a high concentration (col. 4, lines 21-32). Because the system can be used on-line in an automobile engine, it will be used at varying engine loads (col. 2, lines 45-48). The point in time at which the pump draws engine fluid from the engine does not further limit the claimed structure in any way that distinguishes the claim over the prior patent.

Allowable Subject Matter

10. Claims 2-17, 22-28, 30, 32-56 and 58-68 are allowed.
11. Claim 57 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
12. The following is an examiner's statement of reasons for allowance: Reasons for allowance of claims 11, 26, 27, 32 and their dependents are given in the previous office action. Claims 3, 9, 12, 41 and their dependents are allowable because they have been amended by the applicant to incorporate limitations not disclosed or suggested in the prior art as stated by the applicant in the remarks filed July 22, 2004. Claim 61 and its dependents are allowable because the prior art of record fails to disclose or suggest a method of detecting contamination of engine fluid comprising providing the fluid to a particle counter, measuring a characteristic of cleanliness of the engine fluid with the counter during engine operation, and identifying a characteristic of a quality of build of the engine based on an analysis of the characteristic of cleanliness.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

13. Applicant's arguments filed July 22, 2004 have been fully considered but they are not persuasive. The examiner agrees with applicant's arguments regarding all of the claims except for claims 18-20, and those claims are indicated as allowable for reasons listed in paragraph 12 above. Applicant argues that the Haarstad and Verdegan patents fail to disclose a filtration system for cleaning engine fluid during an engine dynamometer test, however it is submitted that the new limitation is a process limitation that does not limit the structure of claim 18 in a way that distinguishes it from that of the prior patents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank M. Lawrence whose telephone number is 571-272-1161. The examiner can normally be reached on Mon-Thurs 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank M. Lawrence
Primary Examiner
Art Unit 1724

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Frank Lawrence

11-16-04